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TRANSMITTAL LETTER General - Patent Pending	Docket No. 112703-090
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In Re Application of **Richey et al.**

Application No. 09/681,692	Filing Date May 22, 2001	Examiner A. Corbin	Customer No. 29156	Group Art Unit 1761	Confirmation No. 5308
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Title:
COATED CHEWING GUM PRODUCTS AND METHODS FOR MAKING SAME

COMMISSIONER FOR PATENTS:

Transmitted herewith is:

**Appellants' Reply Brief (3 pages) (triplicate); and
 Return Receipt Postcard**

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Signature

Dated: **December 22, 2004**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants: Richey et al.
Appl. No.: 09/681,692
Conf. No.: 5308
Filed: May 22, 2001
Title: COATED CHEWING GUM PRODUCTS AND METHODS FOR MAKING
SAME
Art Unit: 1761
Examiner: A. Corbin
Docket No.: 112703-090

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P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' REPLY BRIEF

Dear Sir:

I. **INTRODUCTION**

This Reply Brief is submitted in support of the Appeal filed on January 13, 2004 from the final rejection of the above-identified patent application. More specifically, this Reply Brief is submitted in response to the Examiner's Answer mailed on October 26, 2004. Because this Reply Brief is being submitted within two months from the Examiner's Answer, it is timely. This Reply Brief addresses the new arguments set forth in the Examiner's Answer.

II. **THE REFERENCES IN AND OF THEMSELVES DEMONSTRATE THAT THE
OBVIOUSNESS REJECTION IS NOT PROPER**

Of course, every invention, whether patentable or not, in hindsight is obvious. Thus, the Federal Circuit has mandated "the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested

the desirability of the modification.” *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-84 (Fed.Cir. 1992).

One of the threshold issues on appeal is whether or not the references of record, *McGrew* and *Yatka*, suggest the desirability of the modification posed by the Examiner, i.e., whether it is obvious to combine *Yatka* with *McGrew*. Appellants have pointed out that one skilled in the art would not be motivated to combine *Yatka* with *McGrew*, as *McGrew* is directed to a wax-free chewing gum whereas *Yatka* utilizes wax.

In the first instance, the Examiner’s Answer states that this issue is irrelevant since only Claim 8 claims a wax-free product. This is not the point of this line of argument. Rather, Applicants are pointing out why it would not be obvious to one skilled in the art to modify *McGrew* based on *Yatka*. Thus, whether or not Applicants claim a wax-free chewing gum or not is not relevant to a lack of motivation to combine the two references. This issue is directed to whether or not the references teach away from the suggested combination.

In addition, the Examiner states that “none of *Yatka*’s examples or tables use any waxes, despite Appellants’ contrary belief.” (See page 3). This statement is, it is respectfully submitted, incorrect as a matter of fact.

Yatka sets forth five tables and 15 examples. In each of the tables and examples the gum base portion is referred to merely as “base.” In the specification, it is stated “the insoluble gum base generally comprises elastomers, elastomer solvents, plasticizers, waxes, ...” (See column 4, lines 53-55). “Commonly employed waxes include paraffin, microcrystalline, and natural waxes such as bees wax and carnauba.” (See column 4, lines 66-67 and column 5, line 1). Thus, one skilled in the art viewing *Yatka* for what it teaches would be led to believe that each and every one of the base formulations includes waxes.

In fact, this comports with the disclosure of *McGrew* which is directed to a low calorie high base wax-free gum base, *McGrew* states that one cannot merely remove wax from a gum base without compromising certain desirable characteristics. Accordingly, one skilled in the art viewing the art for what it teaches would be led to believe that in all of the examples of *Yatka*, wax is utilized as the only disclosed bases include wax. Therefore, for this reason alone, the Board should reverse the Examiner’s rejection as it is based on a misstatement of fact.

III. THE EXAMINER ERRED IN NOT CONSIDERING UNEXPECTED RESULTS SET FORTH IN APPLICANTS' PATENT APPLICATION

Appellants noted in their Appeal Brief that pages 8-10 of the patent application demonstrate unexpected results in coated chewing gum formulations. The Patent Office states that this is not convincing as there is no comparison with the closest prior art *McGrew*.

First, Appellants do not believe that it is necessary in order to demonstrate unexpected results to compare the claimed invention with the prior art being asserted by the Patent Office. How does an Applicant know at the time he files a patent application what the Examiner will consider the closest prior art? Using this line of reasoning, Applicants would be advised to never submit test data or comparable examples in their patent application. What is the closest prior art is a subjective determination. What Appellants have done is demonstrated unexpected results utilizing the formulation of the present invention. This is entitled to patentable weight and cannot be summarily dismissed as it has been in the instant case by the Examiner.

Secondly, Appellants' unexpected results relate to coated chewing gum. *McGrew* is not even a coated chewing gum product. Thus, how can Appellants' compare the claimed invention and its unexpected results achieved in coated chewing gum against a product that does not even have a coating?

Appellants respectfully submit that it was an error for the Patent Office not to consider the secondary considerations set forth in Appellants' claimed invention.

IV. CONCLUSION

For the foregoing reasons, Appellants respectfully request that this Board reverse the Examiner's rejections as they are based on an incorrect interpretation of the facts and law.

Respectfully submitted,

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